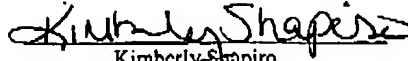


CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)			Docket No.
Applicant(s): Sung-Tsuen Liu			02-215
Application No. 10/717,310	Filing Date 11/19/03	Examiner Peter J. Lish	Group Art Unit 1754
Invention: Stabilized Vaterite			RECEIVED CENTRAL FAX CENTER MAR 31 2005
<p>I hereby certify that this _____ Response to Restriction Requirement (3 pages) <i>(Identify type of correspondence)</i></p> <p>is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. 703-872-9306)</p> <p>on March 31, 2005 <i>(Date)</i></p> <p style="text-align: center;">_____ Kimberly Shapiro <i>(Typed or Printed Name of Person Signing Certificate)</i></p> <p style="text-align: center;">_____ <i>(Signature)</i></p> <p>Note: Each paper must have its own certificate of mailing.</p> <p style="text-align: right; margin-right: 50px;">4 pages including this page</p>			

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Kimberly Shapiro

DOCKET NO. 02-215

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: application of: :
Sung-Tsuen Liu :
Serial No. 10/717,310 : Group Art Unit: 1754
Filed: November 19, 2003 : Examiner: Peter J. Lish
For: Stabilized Vaterite :
X

Assistant Commissioner for Patents
Washington, DC 20231

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Office Action mailed March 11, 2005 in the above-identified application.

In this Office Action, the Examiner has required restriction between the claims of:

Group I (claims 1 to 5), which are drawn to calcium carbonate, allegedly classified in Class 423, Subclass 430;

Group II (claims 6-11 and 20), which are drawn to a dentifrice composition, allegedly classified in Class 106, Subclass 35; and

Group III (claims 12-19), which are drawn to a method of forming calcium carbonate, allegedly classified in class 423, subclass 165.

The Examiner takes the position, per M.P.E.P. §806.05(d), that the inventions of Group II and Group I are related as subcombinations, distinct from each other because they are

separately usable, specifically the Invention of Group I has a separate utility than use in the Dentifrice Compositions of Group III, such as in the papermaking industry.

The Examiner takes the position, per M.P.E.P. §806.05(f), that the inventions of Group I and Group III are related as process for making a product and product made and that the inventions are distinct because the product can be made by a materially different process than the process recited in claims 12-19, such as by reacting calcium hydroxide with carbon dioxide.

The Examiner takes the position, per M.P.E.P. §806.04 that inventions of Group II and Group III are unrelated because they are not capable of use together and they have different modes of operation, different functions, or different effects. Specifically, in the present case the Examiner maintains that the invention of Group II and Group III have different functions, specifically the Group II invention is a composition for oral care, and the Group III invention is a method of making calcium carbonate.

Applicants respectfully traverse this restriction requirement as follows.

In order to substantiate a restriction requirement of the claims of a patent application, the Examiner must make two showings: first, that the claims recite independent or distinct invention, and second, that examining all of the claimed inventions in a single application would constitute a serious burden. Because the Examiner has not made a *prima facie* showing that a search and examination of the entire application would be a serious burden, but has instead focused solely on whether the claims recite distinct inventions, the restriction requirement is inappropriate and should be withdrawn.

In particular Applicants maintain that examining all of the claims inventions in a single application would not constitute a serious burden because the claims of the three designated groups have not acquired a separate status in the art, notwithstanding possible different art classifications that may artificially be assigned. Art very relevant to the patentability of any of the claims may be found not only in the specific group in which the claim has been placed, but in any of Groups I- III. In short, the classifications cited to support restriction are merely for cataloging purposes and are not conclusive of the propriety of restriction. It is submitted that the claims of the three groups designated by the Examiner are closely interrelated and in order to preserve unity of invention, all three groups should be prosecuted in the same application.

Indeed, the very possible likelihood that art relevant to each of these groups will be found in their overlapping classifications, means that it is practicable for the Examiner to preserve the unity of invention of this application and examine all of the patent claims in a single examination. In fact, the Examiner is required by M.P.E.P. §803 to make a *prima facie* case showing that a search and examination of the entire application will result in a serious burden to the Examiner. The Examiner has not made any such minimal showing. Rather the Examiner's comments relate solely to explaining that the inventions of Groups I-III are distinct from one another. The Examiner then concludes that because Groups I-III are purportedly distinct from each other they have acquired a separate status in the art and restriction for examination purposes is proper. However, the Examiner provides no explanation as to why a search and examination of the entire application would be a serious burden, as he is required to.

Accordingly because the Examiner has not made a *prima facie* showing that a search and examination of the entire application would be a serious burden, the restriction requirement is inappropriate and should be withdrawn.

Provisional Election

Nonetheless, in an effort to expedite prosecution of the application on the merits, Applicants hereby provisionally elect in response to the written restriction requirement, with traverse, the claims of Group I (claims 1 to 5), which are drawn to a calcium carbonate. The Examiner is respectfully requested to contact the undersigned with any questions that might arise at the telephone number indicated below. Reconsideration of the restriction requirement and an early examination of the claims are respectfully requested.

Dated: 31 March 2005

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Respectfully submitted,

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